

sub c67 35. (Twice Amended) In a prize distribution network comprising a plurality of gaming machines connected to a prize server, a method for distributing information about prizes available on specific gaming machines, the method comprising,

establishing communication with each gaming machine connected to the prize server; and

B10 sending prize information from a memory on the prize server to a memory on each gaming machine, said prize information specific to prizes which are available for selection by game players as game awards on games played on the gaming machines

wherein the prizes include cash prizes and non-cash prizes and wherein at least one gaming machine is operable to receive a wager on an outcome for a game of chance, to receive a prize selection corresponding to an award for at least one outcome for the game of chance, to determine the outcome for the game of chance, to display the outcome for the game of chance, to award the selected prize when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same.

B11 36. (Amended) The method of claim 35, wherein the game of chance is a slot game, a keno game, a lottery game, or a poker game.

37. (Amended) The method of claim 35, wherein the prizes are selected from the group consisting of merchandise, vacations, airline miles and shopping spree.

### REMARKS

Claims 1-44 are currently pending in the application. Claims 1, 3, 5, 14, 21, 22, 24, 26, 30, 31, 32, 35, 36 and 37 have been amended. The applicant believes the claim amendments do not add any new matter. The game play sequence described in claim 1 is described in the specification at various locations and in particular with respect to FIG. 7.

### *Specification*

The examiner objected amendment filed Jan 14, 2002 under 35 U.S.C. § 132 because the Examiner has asserted it introduces new matter into the disclosure. The examiner has said that "receive prize fulfillment information used to redeem prizes won" is not supported in the specification. The applicant believes this matter is not new and is supported in the following paragraphs from the specification and the rejection is overcome thereby.

From the specification page 17, line 28 to page 18, line 4 (last paragraph of the description of FIG. 4),

*In one embodiment, the prize server 402 may be connected to a prize fulfillment center 450. Thus, when a player wins a specific prize on the gaming machine 400, the prize information is sent from the gaming machine to the prize server 402. Then, the prize information is sent over a network 452 to the prize fulfillment center 450. The purpose of the prize fulfillment center is to acquire and transfer the prize won by the player to the player. For example, when a player wins a computer, the prize fulfillment center might order the computer from a vendor and have it shipped to the player's home address. As another example, the prize fulfillment center might send a request to a nearby warehouse and have the prize delivered to a location in the casino where the player can pick up the prize.*

From the specification page 21, line 18 to line 28 (last paragraph of the description of FIGs. 6A and 6B),

*As part of the prize distribution network 602, the prize server 602 may be connected to a prize fulfillment center 650 via a network 652 as described with reference to Fig. 4. Thus, when a player wins a specific prize on one of the gaming machines, the prize information is sent from the gaming machine to the prize server 602 and over a network 652 to the prize fulfillment center 650. The purpose of the prize fulfillment center is to acquire and transfer the prize won by the player to the player. For example, when a player wins a computer, the prize fulfillment center might order the computer from a vendor and have it shipped to the player's home address. As another example, the prize fulfillment center might send a request to a nearby warehouse and have the prize delivered to a location in the casino where the player can pick up the prize.*

#### ***Rejections under 35 U.S.C. § 112***

The Examiner rejected claim 43 under 35 U.S.C. 112 first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed had possession of the claimed invention. In particular, the Examiner asserts that the originally filed disclosure does not support a prize server configured to receive information used to redeem prizes such as in a redemption system. The applicant respectfully traverses this rejection.

The two paragraphs above the specification as originally filed describe that "when a player wins a specific prize on one of the gaming machines, the prize information is sent from

the gaming machine to the prize server 602 and over a network 652 to the prize fulfillment center 650." Further from the specification, "the purpose of the prize fulfillment center is to acquire and transfer the prize won by the player to the player." Thus, the specification supports that the prize server is receiving information from the gaming machine that is used to redeem prizes, such as via the prize fulfillment center, as the prize information is sent from the gaming machine to the prize server and then sent to the prize fulfillment center. Therefore, the applicant believes rejection of claim 43 under 35 U.S.C. 112 first paragraph is overcome thereby.

### *Rejections under 35 U.S.C. § 102*

The Examiner rejected claims 1-2, 4, 6-25, 27-30 and 32-44 under 35 USC 102(e) as being clearly anticipated by Kelly (US patent No. 6015344). The rejections are respectively traversed.

Kelly does not describe a gaming machine that can be used to make a wager on the outcome of a game of chance played on the gaming machine. Further, in Kelly, the ability to select a prize corresponding to the outcome of a game of chance is not described. In Kelly, a prize redemption system is described where the player can select a prize that can be redeemed for tickets or prize credits earned while playing the gaming machine. Details of Kelley are described as follows.

In Kelly, a prize redemption system is provided where the player pays to use a game apparatus. While playing the game apparatus, the player can earn prize credits that can be exchanged for prizes (Abstract). **In Kelly, the players do not make wagers on the outcomes of a game of chance or select prizes for the outcomes.** Instead, the players pay to use the game apparatus. Monetary input device 14 is used to receive monetary input that is inserted by a player into the game apparatus in the gaming environment. For example, coins can be received in return for the player's use of the game apparatus (Col. 7, 1. 40-43).

In Kelly, a player can obtain prizes in two ways: 1) either by accumulating enough tickets or 2) via an instant win. The amount of universal tickets dispensed to the player is typically based upon a game score or other result of a game process. The tickets are used as a medium of conversion from game score to prize value (Col. 10, 1. 30-36). The more valuable the prize, the greater number of tickets required to redeem the prize (Col. 10, 1. 15-17). A specific prize can also be won where the player can receive the prize due to a particular result winning result on the game unit (Col. 10, 1. 54-57). After accumulating tickets, a prize selection unit can be used to redeem prizes. A prize selection menu provides a list of prizes and also includes a prize cost or value for each displayed prize. A player can select any of the prizes for which he or she has enough prize credits (Col. 29, 1. 39-51). The prizes that a player can select are determined by the operator of the game unit (See FIG. 9).

In contrast, the present invention, as described in claim 1, recites "a master gaming controller designed or configured to control a game play sequence on the gaming machine for a game of chance, said game play sequence comprising: 1) receiving a wager on an outcome for the game of chance, 2) receiving a prize selection corresponding to an award for at least one outcome for the game of chance." In Kelly, the player provides money to use the game apparatus to play a game. Wagers on the outcome of a game of chance are not described in Kelly. In Kelly, after accumulating enough tickets, a player can redeem the tickets for a selected prize. However, selecting a prize as an award for the outcome of a game of chance on which a wager has been made is not described in Kelly. Therefore, Kelly can't be said to anticipate claims 1-2, 4, 6-13, and withdrawal of the rejections is respectfully requested. Using similar reasoning for claims 14-25, 27-30 and 32-44, (claims 14-25, 27-30 and 32-44 have limitations similar to claim 1), Kelly can't be said to anticipate these claims and withdrawal of the rejections is respectfully requested.

### *Rejections under 35 U.S.C. § 103*

The Examiner rejected claims 1-44 U.S.C. 103 (a) as being unpatentable over Walker et al. (6,068,552) in view of Kelly (US patent No. 6015344). The rejection is respectfully traversed.

Kelly, Walker or the combination of Kelly and Walker do not describe a gaming machine where a non-cash prize can be selected for an award of an outcome of a game of chance and then awarded when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same. Further, **Kelly clearly states that it is difficult to provide non-cash prizes.** From Kelly, (Col. 1, 52- Col. 2, 1. 2) it describes that "maintaining a redemption system can be very involving for the operator of an arcade, to the point of being burdensome," such as costs associated with maintaining a prize booth. Further, "requiring even greater maintenance is the setting and adjustment of ticket costs or the prices of prizes." "The task can become overwhelming when a large variety of prizes are offered and many different types of games can be played."

In Walker, a gaming machine is described where the player may customize the odds, pay-out schedule and wager amounts and the gaming machine automatically determines changes in other parameters which were not customized to maintain a constant house advantage (Abstract). The player may customize a "cash" pay schedule which is amount paid for each real combination shown, based on an amount wagered (Col. 4, 1. 43-55). The player's preferences for customizing the gaming machine can be stored on the slot server and retrieved by the player identifier when the player inserts a player-tracking card into the machine (Col. 11, 1. 14-20). In Walker, the figures do not show or suggest any non-cash prizes of any kind which may be awarded to a player in response to a game outcome generated on the gaming machine and the specification does not describe suggest any non-cash prizes and methods of awarding non-cash prizes in any manner. For instance, FIGs. 2, 3, 4A, 4B, 5, 6, 8, 10, 11A, 11B and 12 all show amounts of

credits that are awarded based on the game outcome generated on the gaming machine. The credits have a cash-value based on the amount wagered and can be used for additional game play or cashed out by the player.

In contrast, all of the claims of the present invention describes provisions for a gaming machine that is "operable to receive a wager on an outcome for a game of chance, to receive a prize selection corresponding to an award for at least one outcome for the game of chance, to determine the outcome for the game of chance, to display the outcome for the game of chance, to award the selected prize when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same" where "the prizes include cash prizes and non-cash prizes." In Kelly, wagers on the outcome of a game of chance, selecting a prize as an award for the outcome of a game of chance and awarding the selected prize when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same are not described. Kelly only describes selecting prizes for prize redemption after enough tickets have been accumulated.

The Walker reference describe a gaming device where a user may select different cash payouts as an outcome for a game generated on the gaming device where a constant house advantage is maintained. However, the Walker references only allow the user to select "cash" payout amounts so that the odds of winning the cash payout are changed. The only prize a player may select is cash and no other choices are allowed. The selection of non-cash prizes or the selection between cash and non-cash prizes are not described.

**The Examiner has stated that "the lack of disclosure does not teach away from the claimed invention" and that the motivation for the combination is that "casinos offer or cater to player gaming preferences including prize preferences to attract them to play at their casino so as to increase their revenue thereby since the longer players continue to play the more casinos' revenue is likely to increase."** Walker, however, does not teach prize preferences for the outcome of a game of chance but odds preferences. In Walker, the only prize that a player may choose is cash. The player may adjust their of their odds of winning the cash but can't select among different types of prizes they might prefer such as between cash and non-cash prizes or between different types of non-cash prizes that they might prefer. Kelly clearly describes that is difficult to provide non-cash prizes because of the maintenance and costs required in setting and adjusting prize costs which can become "overwhelming" for a large number of prizes and the maintenance and costs associated with displaying the prizes. Walker provides no teaching or motivation for overcoming the difficulties associated with providing non-cash prizes. Further, in Walker, it is required that a constant house advantage be maintained no matter what selections of the "cash" payouts are made which requires a precise knowledge of the price of prizes so that the necessary calculations may be carried out. Thus, even if Walker were modified, since with "non-cash" prizes the value of the non-cash prizes can change with time, it would be difficult and costly to apply the Walker method to non-cash prizes which

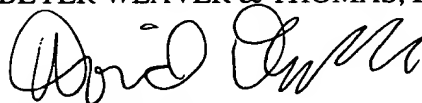
teaches away from the combination. Therefore, Kelly, Walker or the combination of Kelly and Walker can't be said to render obvious the invention as recited in claims 1-44 and the objection is believed overcome thereby.

The Examiner rejected claims 3, 5, 26 and 31 under U.S.C. 103 (a) as being unpatentable over Kelly (US patent No. 6015344) in view of Walker et al. (6,068,552). The rejection is respectfully traversed

As described above, Kelly, Walker or the combination of Kelly and Walker does not teach selecting non-cash prizes as an award for the outcome of a game of chance. For at least these reasons described above, it is respectfully submitted the Walker references can't be said to render obvious the invention as recited in Claims 3, 5, 26 and 31 and withdrawal of the rejection is respectfully requested.

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,  
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## APPENDIX

1. (Twice Amended) A gaming machine comprising:  
a master gaming controller designed or configured to control a game play sequence on the gaming machine for a game of chance, said game play sequence comprising: 1) receiving a wager on an outcome for the game of chance, 2) receiving a prize selection corresponding to an award for at least one outcome for the game of chance, 3) determining the outcome for the game of chance and 4) displaying the outcome for the game of chance including any prize awarded for the determined outcome of the game of chance and 5) awarding the selected prize when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same;  
a memory storing a list of prizes; and  
a prize display mechanism displaying the prizes stored in the memory; and  
a prize selection mechanism used to select one or more prizes [for]corresponding to one or more outcomes of [a]the game of chance played on the gaming machine  
wherein the prizes include cash prizes and non-cash prizes.
2. (Amended) The gaming machine of claim 1, wherein the non-cash prizes are selected from the group consisting of merchandise, vacations, airline miles, and shopping sprees.
3. (Amended) The gaming machine of claim 1, wherein the prize selection mechanism allows the user to select one or more prizes specific to a wager amount of the game of chance played on the gaming machine.
4. The gaming machine of claim 1, wherein the gaming machine is a mechanical slot machine, a video slot machine, a keno game, a lottery game, or a video poker game.
5. (Amended) The gaming machine of claim 1, wherein a probability of the outcome of the game of chance played on the gaming machine is specific to a value of the selected prize.
6. The gaming machine of claim 1, wherein the prize selection mechanism is a key pad, a button panel, a video touch screen, a mouse, a touch pad, a joystick, a microphone or a magnetic card.

7. (Amended) The gaming machine of claim 1, wherein the prize display mechanism is a printed sign, a video display screen, a bonus wheel, a video touch screen, an LCD (Liquid Crystal Display), a back-lit glass panel or a prize.

8. (Amended) The gaming machine of claim 1, wherein the memory is an EEPROM (Electrically Erasable Programmable-Read only Memory), a CD-ROM (Compact Disc-Read Only Memory), DVD (Digital Versatile Disc), a non-volatile memory, or a magnetic storage device.

9. The gaming machine of claim 1, wherein the gaming machine provides a display format for the one or more prizes displayed on the display mechanism.

10. The gaming machine of claim 9, wherein the display format is graphical or textual.

11. The gaming machine of claim 9, wherein the display format indicates a feature of the prize.

12. The gaming machine of claim 11, wherein the prize feature is a prize value.

13. The gaming machine of claim 11 wherein the prize feature is a prize theme.

14. (Twice Amended) A prize server comprising;  
an interface for providing prize information to one or more gaming machines wherein at least one of the gaming machines is located external to the prize server; and  
a memory storing the prize information as groups of prizes for separate display on the one or more gaming machines  
wherein the prizes include cash prizes and non-cash prizes and wherein at least one gaming machine is operable to receive a wager on an outcome for a game of chance, to receive a prize selection corresponding to an award for at least one outcome for the game of chance, to determine the outcome for the game of chance, to display the outcome for the game of chance and to award the selected prize when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same.

15. (Amended) The prize server of claim 14, wherein the non-cash prizes are selected from the group consisting of merchandise, vacations, airline miles, and shopping sprees.

16. (Amended) The prize server of claim 14, wherein the memory is an EEPROM(Electronically Erasable Programmable-Read only Memory), a CD-ROM(Compact Disc-Read Only Memory), a non-volatile memory, or a magnetic storage device.

17. The prize server of claim 14, further comprising a second interface to an output mechanism wherein the second interface is configured to send prize information to the output mechanism.

18. The prize server of claim 17, wherein the output mechanism is a printer, a magnetic card reader, optical card reader, smart card reader, or a mechanism for electronically crediting a pre-existing account.

19. The prize server of claim 14, wherein the interface is a fiber optic cable, a coaxial cable, or a wireless interface.

20. (Amended) The prize server of claim 14, wherein the display is a video display screen, a touch screen, or a LCD (Liquid Crystal Display).

21. (Twice Amended)A prize distribution network comprising;

(a) a prize server comprising;

An interface for providing prize information to one or more gaming machines

wherein at least one of the gaming machines is external to the prize server; and

a memory storing the prize information as groups of prizes for separate display on the one or more gaming machines; and

(b) a plurality of gaming machines each gaming machine comprising;

a memory storing a list of prizes; and

a prize display mechanism displaying the prizes; and

a prize selection mechanism used to select one or more prizes for one or more outcomes of a game of chance played on the gaming machine

wherein the prizes include cash prizes and non-cash prizes and wherein at least one gaming machine is operable to receive a wager on an outcome for a game of chance, to receive a prize selection corresponding to an award for at least one outcome for the game of chance, to determine the outcome for the game of chance, to display the outcome for the game of chance and to award the selected prize when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same.

22. (Amended) The prize distribution network of claim 21, wherein the [machine] the game of chance is selected from the group consisting of [is a mechanical slot machine, a video slot machine,] a slot game, a keno game, a lottery game, or a [video] poker game.

23. (Amended) The prize distribution network of claim 21, wherein the non-cash prizes are selected from the group consisting of merchandise, vacations, airline miles, and shopping sprees.

24. (Twice Amended) In a gaming machine having a prize selection mechanism, a prize display mechanism for displaying a list of prizes, a method of selecting a prize specific to an outcome of a game of chance played on a gaming machine, the method comprising;

displaying multiple prizes available for selection in the prize display mechanism;

receiving an input signal from the prize selection mechanism for selecting a prize from the list of prizes, said input signal corresponding to a user's selection of the selected prize wherein the selected prize corresponds to an award for one of the outcomes of the game of chance;

receiving a [game play signal] wager for the game of chance [and]

determining the [game play] outcome for the game of chance;

[presenting the game play and game play outcome]

presenting the outcome for the game of chance; and

awarding the selected prize when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same

wherein the prizes include cash prizes and non-cash prizes.

25. (Amended) The method of claim 24, wherein the non-cash prizes are selected from the group consisting of merchandise, vacations, airline miles, and shopping sprees.

26. (Amended) The method of claim 24, further comprising determining a pay table to be used in determining [a game play outcome] the outcome for the game of chance, wherein the pay table is chosen according to the value of the selected prize.

27. The method of claim 24, further comprising outputting the selected prizes to a portable memory device.

28. (Amended) The method of claim 27, wherein the portable memory device is a magnetic card, a personal digital assistant or a smart card.

29. The method of claim 24, wherein the prize selection mechanism is a key pad, a button panel, a touch screen, a mouse, touch pad, joystick, a microphone, a smart card or a magnetic card.

30. (Amended) The method of claim 24, further comprising receiving a signal for initiating the game of chance [a wager amount prior to receiving an input signal from the prize selection mechanism].

31. (Amended) The method of claim [30]24, further comprising displaying a group of prizes available for selection in the prize display mechanism specific to [the] a wager amount.

32. (Amended) The method of claim 24, wherein the [gaming machine] game of chance is a [mechanical] slot game [machine, a video slot machine,] a keno game, a lottery game, or a [video] poker game.

33. The method of claim 24, further comprising displaying the selected prize on the prize display mechanism.

34. (Amended) The method of claim 24, wherein the prize display mechanism is a printed sign, a video display screen, a bonus wheel, a video touch screen, back-lit glass panel or an LCD (Liquid Crystal Display).

35. (Twice Amended) In a prize distribution network comprising a plurality of gaming machines connected to a prize server, a method for distributing information about prizes available on specific gaming machines, the method comprising,

establishing communication with each gaming machine connected to the prize server; and

sending prize information from a memory on the prize server to a memory on each gaming machine, said prize information specific to prizes which are available for selection by game players as game awards on games played on the gaming machines

wherein the prizes include cash prizes and non-cash prizes and wherein at least one gaming machine is operable to receive a wager on an outcome for a game of chance, to receive a prize selection corresponding to an award for at least one outcome for the game of chance, to determine the outcome for the game of chance, to display the outcome for the game of chance and to award the selected prize when the determined outcome for the game of chance and the outcome for the game of chance corresponding to the prize selection are the same.

36. (Amended)The method of claim 35, wherein the [machine]game of chance is a [mechanical slot machine, a video slot machine,]slot game, a keno game, a lottery game, or a [video] poker game.

37. (Amended) The method of claim 35, wherein the [non-cash] prizes are selected from the group consisting of merchandise, vacations, airline miles[,] and shopping sprees [and cash].

38. The method of claim 35, further comprising displaying the prize information to a video display screen associated with one or more of the gaming machines.

39. The method of claim 38, further comprising identifying one or more prizes selected by a user.

40. The method of claim 39, further comprising outputting the selected prize information to a portable storage device, which can be read by one or more of the gaming machines.

41. The method of claim 24, further comprising:  
printing a record of the selected prizes.

42. The prize server of claim 14, wherein the prize server is a gaming machine.

43. The prize server of claim 14, wherein the prize server is configured to receive prize fulfillment information used to redeem prizes won by players playing the gaming machines.

44. The prize distribution network of claim 21, further comprising:  
a prize fulfillment center that is used to acquire and deliver prizes.